

REMARKS

Claims 1, 42, 47, and 51-59 have been canceled without prejudice or disclaimer. Claims 1, 23, 41, and 50, as amended, and claims 45, 46, and 48 are pending in the instant application. No new matter has been added as a result of the above-described amendments. The rejections set forth in the Office Action have been overcome by amendment or are traversed by argument below.

1. Provisional rejection of claims 1, 23, 41, 45-48, and 50-59 for double patenting

The Action asserts a provisional rejection of claims 1, 23, 41, 45-48, and 50-59 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1, 23, 41, 45-48, and 54-62 of copending U.S. Application No. 09/898,234 (the ‘234 Application). The Action states that the only difference between the claims of the instant application and those of the ‘234 Application is the recitation, in the instant claims, of a polypeptide that is not associated with human urinary proteins. The Action also states that because the polypeptide recited in each set of claims is recombinantly produced, neither the polypeptide recited in the instant claims nor the polypeptide recited in the claims of the ‘234 Application would be associated with urinary proteins. The Action concludes, therefore, that the limitation recited in the instant claims has no meaning, and as a result, that the claims of the instant application and those of the ‘234 Application are identical in scope.

Applicants note that a provisional rejection based on the statutory type of double patenting can be avoided by either amending the claims of one application so that they are not coextensive in scope or by canceling the claims of one application (M.P.E.P. § 804.02). Applicants also note that the instant claims have been amended to recite a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a therapeutically effective amount of an isolated polypeptide having the ability to bind TNF, wherein said polypeptide is not associated with human urinary proteins, and wherein said polypeptide comprises the amino acid sequence as set forth in SEQ ID NO: 4. Applicants contend, therefore, that the claims of the instant application and those of the ‘234 Application are no longer identical in scope.

2. Provisional rejection of claims 1, 23, 41, 42, 45-48, and 50-59 for obviousness-type double patenting

The Action maintains the rejection of claims 1, 23, 41, 42, 45-48, and 50-59 under the

judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,417,158 (the '158 Patent). The Action also maintains the provisional rejection of claim 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 42 and 51-53 of the '234 Application.

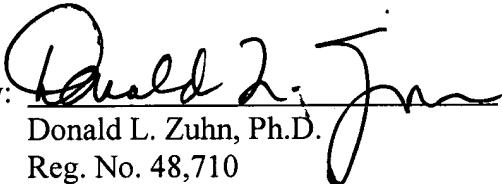
Applicants acknowledge the rejections under the doctrine of obviousness-type double patenting, and elect to address these grounds of rejection by submitting a Terminal Disclaimer or by argument upon notification that all other conditions for patentability have been met, and the claims are otherwise in condition for allowance.

CONCLUSIONS

Applicants respectfully contend that all conditions of patentability are met in the pending claims as amended. Allowance of the claims is thereby respectfully solicited.

If Examiner O'Hara believes it to be helpful, she is invited to contact the undersigned representative by telephone at 312-913-0001.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

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By: 
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